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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,693	07/28/2000	Julien Haroche	03495.0193	3389

22852 7590 10/03/2003

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WASHINGTON, DC 20005

EXAMINER
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PAK, YONG D

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 10/03/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/628,693

Applicant(s)

HAROCHE ET AL.

Examiner

Yong D Pak

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 08 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 4-9 and 23-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 8, 9 and 26-32 is/are allowed.
- 6) ☒ Claim(s) 6, 7 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

The amendment filed on April 8, 2002, amending the specification, canceling claims 10-22 and 33-41 and amending claims 3-7, 24, 27 and 30, has been entered.

Claims 1-9 and 23-32 are pending.

Rejections and/or objections not reiterated from previous Office action are hereby withdrawn.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on April 8, 2002 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Response to Arguments***

Applicant's arguments filed December 6, 2001 have been fully considered but they are not persuasive.

The statement regarding the biological deposit is given on the Deposit Declaration, Paper No. 12.

***Claim Rejections - 35 USC § 112***

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Claims 6-7 and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants argue that amendment of claim 6 overcomes the rejection. The examiner disagrees. Claim 6 is drawn to DNA encoding allelic variants of the polypeptide of SEQ ID NO:1. Therefore, these claims are drawn to a subgenus of allelic DNAs that encode polypeptides comprising SEQ ID NO:1. The specification discloses only one allele within the scope of the genus, SEQ ID NO:2. There is no description of how the structure of SEQ ID NO:2 relates to the structure of any strictly neutral alleles. The general knowledge in the art concerning alleles does not provide any indication of how the structure of one allele is representative of unknown alleles. Therefore, the specification fails to describe common attributes of the genus.

### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed on April 8, 2002 is sufficient to overcome the rejection of claims 3-4 and 6 based upon Werner et al.

The declaration under 37 CFR 1.132 filed on April 8, 2002 is sufficient to overcome the rejection of claim 5 based upon Allignet et al.

The declaration under 37 CFR 1.132 filed on April 8, 2002 is sufficient to overcome the rejection of claims 6-7 and 23-25 based upon Rende-Fournier et al.

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***Allowable Subject Matter***

Claims 1-5, 8-9 and 26-32 are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong D. Pak  
Patent Examiner

September 25, 2003

  
PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600